

REMARKS

The Office Action mailed December 23, 2008 has been carefully considered.

Reconsideration in view of the following remarks is respectfully requested.

Election Requirement

The application stands subject to a restriction requirement in which Group I has been designated in the Office Action to include claims 1-6; and Group II to include claims 7-13.

The Applicant hereby provisionally elects, with traverse, to prosecute the method claims of Group I, claims 1-6. The Applicant expressly reserves the right to pursue the apparatus claims of Group II in a continuation, continuation-in-part and/or divisional application.

Applicant traverses the restriction requirement. The restriction requirement is based upon PCT Rule 13.1, i.e., it is alleged that the application contains plural inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. Admittedly, Group I claims are “drawn to a method for separating a cast lens from a shell mold” and Group II claims are “drawn to a device for separating a cast lens from a shell mold.” (emphasis added).

In the restriction requirement it is urged that under PCT Rule 13.2 the two claim groups do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or a corresponding special technical feature because: the common technical feature found in both groups is a separating tool for exerting force on a cast lens. It is urged that this element cannot be a special technical feature under PCT Rule 13.2 because the element is shown in the prior art (USP 4251474). Allegedly USP 4251474 teaches separating a cast lens from a shell mold in which a separating tool is provided with a force on the lens along the interface between the lens and the mold shell.

In traverse, first note that USP 4251474 (Blandin) does not disclose the invention claimed in claim 1. Blandin only teaches (col. 5, line 39-55) that the lens is removed from the shell mold as shown in FIG. 3, but FIG. 3 only shows a separating tool. Blandin is silent as to how the separating tool is to be used. From FIG. 3 one of ordinary skill in the art can only determine that the separating tool has the general shape of a spatula. Blandin does not disclose limitations b2) and b3), nor does Blandin disclose any feature of any apparatus for separating the lens from the shell mold apart from the spatula (28) of FIG. 3. Blandin is an example of the method mentioned in paragraph [0004] of the present application in which the lens and the shell molds are separated manually, or of the method mentioned in WO 02/087861 (also referred to in paragraph [0004] of the present application) in which the separating tool engages at a single location and is not guided along the interface between the lens and shell mold. Furthermore, as is readily apparent from FIG. 3 of Blandin, those of ordinary skill in the art will only be taught that Blandin's spatula 28 engages in a gap between the lens and the shell mold. Accordingly, it cannot be maintained that Blandin anticipates claim 1 or renders it obvious and, as a result, the restriction requirement which is based on this premise, should be withdrawn.

Additionally, the restriction requirement should be withdrawn because the International Authorities have acknowledged unity of invention and the International Preliminary Report on Patentability (IPRP) makes no objections in this respect.

Furthermore, Independent claim 1 contains the limitations:

- b1) pressing a separating tool with a force on the lens; and
- b2) rotating either the composite so that the separating tool rolls passively on the lens or rotating the separating tool so that the lens rolls passively on the separating tool,
and
- b3) guiding the separating tool along an interface between the lens and the shell mold.

Independent claim 7 contains the limitations:

- c1) a holding device rotatable on a first axis of rotation,
- c2) a separating tool rotatable on a third axis of rotation,
- c3) a force transmitter for pressing the separating tool laterally against the lens,
- c4) a first motor for rotating the holding device or the separating tool,
- c5) a second motor for adjusting a height H of the separating tool or the holding device, the height measured along the first rotational axis, and
- c6) a control unit that controls the second motor so that the separating tool presses on the lens adjacent to an interface between the shell mold to be separated and the lens, whereby a height H of the separating tool or the holding device follows a height of the interface between the shell mold to be separated and the lens according to the angle of rotation θ .

Thus it is apparent that independent claim 7 is directed to a an apparatus for performing the method of claim 1. The claim calls out some preferred structural features for performing this method. Therefore claims 1 and 7 are linked by a common general concept, namely of relative motion between the composite of lens and shell mold and the separating tool while the separating tool is pressed on the lens and guided along the interface between the lens and the shell mold. Accordingly, there is unity of Invention.

Conclusion

Applicants respectfully request that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-3557.

Respectfully submitted,
NIXON PEABODY LLP

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/david b. ritchie/
David B. Ritchie
Reg. No. 31,562

Nixon Peabody LLP
200 Page Mill Road
2nd Floor
Palo Alto, CA 94306
Tel. (650) 320-7700
Fax (650) 320-7701